

## REMARKS

### I. Introduction

Upon entry of the present amendment, claims 1-38 will be pending in this application. Claims 1, 11, 13, 14, 25 and 27 have been amended to more fully define the invention. Support for the amendments to Claims 1, 11, 13, 25 and 27 appears in the specification at page 18, lines 7-16. No new matter has been added.

### II. Drawings

The Examiner has objected to Figures 1A, 1B, 1C, 2A and 2B of the drawings because they fail to include a "prior art" designation. Applicants respectfully submit that corrected Figures 1A, 1B, 1C, 2A and 2B designated with the legend "Prior Art" are submitted with this Response and overcome the Examiner's objection.

### III. 35 U.S.C. § 112

The Examiner has rejected claim 14 under 35 U.S.C. § 112, second paragraph, as not pointing out and distinctly claiming the subject matter of the invention. The Examiner states that claim 14 recites the limitation "first surface" in line 4 and claims that there is insufficient antecedent basis for this limitation in the claim. Applicants have amended claim 14 to recite "inner surface", which has an antecedent basis in claim 13, instead of "first surface". Applicants respectfully request reconsideration and withdrawal of this rejection.

### IV. 35 U.S.C. § 102

The Examiner rejected claims 1-38 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,925,077 to Williamson et al. The Examiner states that *Williamson et al.* discloses an implantable or acetabular prosthesis having an opening with a tapered section

that preferably comprises a frustoconical taper and insertion member having a head that is spherical or near-spherical that mates with aperture wall for a fluid-tight seal.

*Williamson et al.* discloses an apparatus and method for plugging holes in an acetabular shell. *See* col. 1, lines 7-10. *Williamson et al.* does not disclose a prosthetic component with universal-type holes or openings that can receive and lock any one of a peg, screw, spike or hole cover in place. The hole 90 disclosed in *Williamson et al.* is specifically configured to mate with the plug 98. *Williamson et al.* does not disclose that the hole 90 is adapted to accommodate an insertion member at multiple orientations relative to the component, as is required by Applicants' claims. Therefore, *Williamson et al.* fails to teach all the elements of Applicants' claims.

The Examiner also rejected claims 1-38 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,228,121 to Khalili. The Examiner maintains that *Khalili* discloses an implantable prosthesis with a prosthetic component that has both first and second surfaces, an opening extending from the first surface to the second wherein the wall is tapered such that the inner most end is larger than the outermost end, and an insertion member with a spherical or near-spherical head that mates with the aperture wall for a fluid-tight seal.

*Khalili* discloses an acetabular cup having at least one aperture. A plurality of sleeve components are provided to mate with the apertures. Each sleeve includes a longitudinal bore adapted to receive a fixation element, e.g., a bone screw. *See* col. 2, lines 26-39. The fixation screw 108 mates with the sleeve component 110, which in turn mates with the aperture 114. The aperture 114 is not adapted to receive the fixation screw 108, as required by Applicants' claims, and thus, the sleeve component 110 is necessary.

Claims 1-4, 7, 9-12, 19-22 and 24 are rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,779,240 to Kondo. The Examiner asserts *Kondo* discloses an implantable prosthesis having an opening with an extended frustoconical taper section and an insertion member or screw inserted into opening such that the screw is locked relative to the frustoconical taper section.

The invention is directed to an implantable prosthesis. A prosthesis is an artificial device used to replace a missing body part, such as a limb. *Kondo* discloses a compression plate for the retention and internal fixation of fragments resulting from a bone fracture. Thus, *Kondo* does not disclose a prosthetic component. Further, *Kondo* does not disclose that it can be used with any one of a hole cover, a bone screw, a bone peg or a bone spike. Finally, *Kondo* states that it is preferable that the screw be inserted vertically. The sliding hole described in *Kondo* is not adapted to accommodate an insertion member at multiple orientations relative to the compression plate. Therefore, *Kondo* does not teach all the elements of Applicants' claims.

The Examiner also rejects Claims 1-7, 10-12, 19-21 and 23-24 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,322,652 to Wolter. The Examiner asserts that *Wolter* discloses an implantable prosthesis or bone plate having passage holes with an extended frustoconical taper section into which insertion members with a spherical seat surface or head are placed for securing the bone plate to the bone.

*Wolter* discloses a bone plate for fixing bones that includes passage holes and at least one bone screw or at least one locking bolt. See col. 1, lines 12-14. Figure 2c shows a conical seat surface. The conical seat surface is a single section extending from a first

surface to a second surface. The passage hole lacks a section at the second surface having a smaller diameter than the conical seat surface at the first surface. Thus, *Wolter* fails to teach all the elements of the claims.

To anticipate a claim, a reference must teach each and every element of the claim, either expressly or inherently. *See* M.P.E.P. § 2131. Applicants respectfully submit that none of the cited references teaches each and every element of the claims. Applicants respectfully traverse these rejections and request reconsideration and withdrawal thereof.

#### **V. 35 U.S.C. § 103**

The Examiner has rejected claims 9 and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,322,562 to *Wolter*. The Examiner states that although *Wolter* does not disclose a fluid-tight seal between insertion member and passage hole, it would have been an obvious matter of design choice since such modification involved only a change in the size of a component. Applicants respectfully traverse this rejection and request reconsideration and withdrawal thereof.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. *See* M.P.E.P. §2142.

As explained above, a section at the second surface having a smaller diameter than the conical seat surface at the first surface. There is no suggestion or motivation in *Wolter* or


the knowledge generally available to one of the ordinary skill in the art to modify the passage holes of *Wolter* to achieve the claimed invention. Moreover, the insertion member of claim 19 is for use with a prosthesis having a universal connecting portion. Thus, Applicants respectfully submit that *Wolter* does not teach or suggest all the claim limitations.

### CONCLUSION

In light of the amendments and the above remarks, Applicants are of the opinion that the Office Action has been completely responded to and that the application is now in condition for allowance. Such action is respectfully requested.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's Amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 815-6409 is respectfully solicited.

Respectfully submitted,



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